

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: **ANDERSCH=1**

In re Application of:)	Conf. No.: 2886
)	
Wolfram ANDERSCH et al)	Art Unit: 1612
)	
I.A. Filing Date: 04/20/2004)	Examiner: B. J. Packard
371(c) Date: 12/12/2006)	
)	Washington, D.C.
U.S. Appln. No.: 10/555,105)	
)	
For: ACTIVE SUBSTANCE)	September 30, 2009
COMBINATION BASED ON...)	

PETITION AGAINST RESTRICTION

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, Mail Stop Amendments
401 Dulany Street
Alexandria, VA 22314

Sir:

The applicants respectfully request and petition for reversal of the Examiner's holding that claim 12 added in the amendment of September 16, 2008, is directed to patentably distinct subject matter and is therefore withdrawn from consideration because of original presentation of other, patentably distinct subject matter.

THE FACTS

The present application has been held to have entered the U.S. National Phase on December 12, 2006. The original claims were directed to a pesticidal composition

comprising two specified components (most of the claims including claim 1), a method for controlling pests using such composition, and a process for preparing such a composition. A preliminary amendment was filed on December 12, 2006, slightly modifying the original claims to put them in better form for U.S. practice.

A first action on the merits was mailed on June 16, 2008, rejecting all the pending claims. No restriction requirement and no election of species requirement were imposed.

A reply was filed September 16, 2008, adding claim 12, a composition claim dependent from claim 5, and ultimately dependent from claim 1.

A final rejection was mailed February 19, 2009, in which all the claims except for claim 12 were rejected. New claim 12 was not addressed at all.

A telephone interview was held on July 17, 2009, between applicants' undersigned attorney of record and the examiner in charge, during which applicants requested reopening of prosecution and consideration of claim 12. Applicants filed a paper entitled "Interview Summary" on July 20, 2009, confirming the aforementioned telephone conference.

On August 25, 2009, a new final rejection was mailed in which claim 12 was held to be withdrawn. On page 2, under the heading "Elections/Restrictions", the following text appears:

Newly submitted claim 12 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The core structures of the species of claim 12 are distinct from the other species of the independent claim.

Since applicant has received an action on the merits for the originally presented invention, this species election has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 12 is withdrawn from consideration as being directed to a non-elected species....

Action Requested

Applicants request that the election/restriction be vacated and that claim 12 be examined on the merits.

Remarks

Claim 12 ultimately depends from claim 1 and thus cannot possibly have a different core structure from species encompassed by claim 1. Any species defined in a dependent claim must be encompassed by the claim from which it depends. Moreover, there was never any election of species requirement previously made, and applicants never made an election of species.

The examiner may now not properly elect a species for the applicants when the applicants were never given and never had the opportunity to make any such election, and the examiner cannot properly take the position that applicants have elected something other than the embodiments covered by claim 12 when applicants never made any other election.

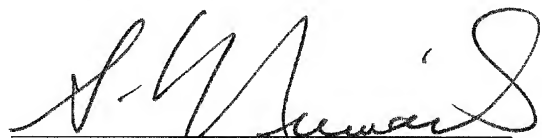
Applicants know of no authority permitting the examiner to make an election of species for an applicant without any input from the applicant.

Accordingly, the present applicants respectfully request that the examiner's holding of claim 12 to be non-elected by original presentation of a different species be vacated, and that applicants be provided with results of an examination on the merits of claim 12.

Respectfully submitted,

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